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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,536	04/10/2002	Peter John Rogers	HACK 207	6203
24972	7590	09/23/2004	EXAMINER	
FULBRIGHT & JAWORSKI, LLP 666 FIFTH AVE NEW YORK, NY 10103-3198			SAYALA, CHHAYA D	
			ART UNIT	PAPER NUMBER

1761

DATE MAILED: 09/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/031,536

Applicant(s)

ROGERS ET AL.

Examiner

C. SAYALA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 07 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 58-77 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 58-77 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
2. Claim 76 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 73 is to spent grain liquor *or* malt extract. Claim 76 is to both and does not further limit the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 58-66, 68, 70-73 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 51022577 in light of JP 75002901 and US Patent 3713838 (to Ziegler), both these patents used as evidentiary references to show what is inherent.

The '577 patent abstract teaches a fertilizer of the claimed composition for use on turf. The composition inherently contains the ingredients of claim 59 as known in prior art (see spec at p.6, citing JP '901). The composition inherently contains yeast since it

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was obtained as a waste from brewery fermentation (see col. 2 in Ziegler). The claim that recites the method of application is not novel; both methods are conventional methods in fertilizer application. The benefit of applying this composition would be inherent, thus meeting claim 71 limitations.

4. Claims 58-66, 68, 71, 72-73 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 02022191 or JP 05163089.

The patent abstracts teach the use of beer refuse or consisting of malt residue, which is used as compost or fertilizer, respectively. The composition would inherently contain the limitations of claim 59 (see paragraph above). The composition has microorganisms added to it and meets claim 49. Composts are mechanically spread onto the soil. The benefit of applying this composition would be inherent, thus meeting claim 71 limitations.

5. Claims 58-67, 72-75 are rejected under 35 U.S.C. 102(b) as being anticipated by Brokken (US Patents 4960452 and 4661358).

Calcium is added to brewer's wort. The composition is dried and powdered for use as a fertilizer. See the abstracts and cols. 2 and 3, and paragraph under "Preparation". The patents teach addition of the composition by spraying and application to soil, respectively. The benefit of applying this composition would be inherent, thus meeting claim 71 limitations. Note that wort is being interpreted as known in prior art, which is as spent grain liquor, or in its concentrated form, as malt extract.

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6. Claims 58-68, 70-73 are rejected under 35 U.S.C. 102(b) as being anticipated by AU 159/66.

See claim 1, page 4, page 5 (second paragraph), page 14, last 4 lines, page 17. The patent teaches fermentation or spent waste liquor from alcoholic fermentation can be dried and used as a fertilizer. Limitations of claims 59 or 63 are shown to be inherent to the composition by the specification itself (page 6). Yeast is part of the alcoholic fermentation process. Methods of application of the fertilizer claimed are the only known and conventional alternatives of each other. The benefit of applying this composition would be inherent, thus meeting claim 71 limitations.

7. Claims 58-68, 70-73 are rejected under 35 U.S.C. 102(b) as being anticipated by AU 12453/28 or Bass (US Patent 3983255).

The patents teach fermentation distillery waste can be dried and used as a fertilizer. Limitations of claims 40 or 44 are shown to be inherent to the composition by the specification itself (page 6). Yeast is part of the alcoholic fermentation process. Methods of application of the fertilizer claimed are the only known and conventional alternatives of each other. The benefit of applying this composition would be inherent, thus meeting claim 71 limitations.

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 69-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 02022191 in view of JP 05163089 and Stitt (US Patent 3961078) and further in view of Ziegler.

The JP '191 is as discussed above. The patent teaches microorganisms are to be used with the brewery waste to ferment the beer refuse to obtain the compost. The patent does not appear to teach what such microorganisms are. JP '089 teaches the use of thermophilic bacteria to ferment brewery waste and Stitt provides the details of what such microorganisms are. See col. 6, lines 10-25; and col. 3, lines 12-15 and line 30 wherein the conversion of brewery waste is listed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to choose such microorganisms to ferment the same brewery wastes. Furthermore, the presence of yeast in brewery waste would have been obvious given Ziegler's teaching at col. 2.

9. Claims 76 and 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brokken (US Patents 4960452 and 4661358) in view of Targan (US Patent 4496605) and Daoud (US Patent 4844932)..

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Brokken teaches using wort as a fertilizer when chelated and dried. It would have been obvious to use both malt extract and spent grain liquor since it is well known in the art that wort is spent grain liquor and in its concentrated form, it is malt extract. See patents to Targan and Daoud.

Response to Arguments

Applicant's arguments filed 6/29/2004 have been fully considered but they are not persuasive.

Applicant's entire response is based on his argument that the spent grain liquor and malt extract are pre-fermentation wastes and the references are all to post-fermentation wastes. The claims do not exclude the addition of yeast, and bacteria. These additives will no doubt bring about fermentation. See page 15, last paragraph of the specification. On the one hand applicant argues that his invention and claims are to pre-fermentation wastes, while his invention and claims do not exclude the fermentation or the additives that cause fermentation. With regard to the reference of Brokken, applicant has stated that "wort" is a post-fermentation waste, when it is well known that wort is the unfermented liquid (runnings or that is obtained from mashing). See the references to Targan and Daoud as well as the dictionary meanings made of record. Wort is concentrated to a syrupy malt or to a powder. In order to establish patentability, applicant must determine whether his claims are to include fermentation processes or not, before he can distinguish his claims over prior art applied here, with the position he has now taken, which is not convincing. The Brokken patent is drawn to using wort as

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a fertilizer and renders both malt extracts and spent grain liquor obvious as claimed in claims 76 and 77, the difference being that one is concentrated wort and the other is plain wort.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note the dictionary meaning of malt includes the information that malt particles are used as fertilizer.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. SAYALA whose telephone number is 571-272-1405.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



C. SAYALA
Primary Examiner
Group 1700.